

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: James R. Tighe
Serial No.: 10/810,512
Filed: 03/26/2004
Group No.: 2619
Confirmation No.: 1184
Examiner: Mounir Moutaquakil
For: SUPPORTING ENHANCED MEDIA COMMUNICATIONS
USING A PACKET-BASED COMMUNICATION LINK

MAIL STOP AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicant requests review of the rejections to the Application outstanding in the Final Office Action transmitted February 11, 2008 (“*Office Action*”) and the Advisory Action dated May 9, 2008 (“*Advisory Action*”). Claims 1-22 and 24-39 are pending in the Application and are all rejected. As the rejections contain clear factual and legal deficiencies, Applicant respectfully requests review and favorable action in this case.

I. Rejections under 35 U.S.C. § 102(b)

The Examiner rejects Claims 1-8, 10-17, 22, and 24-39 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,574,724 issued to Bales et al. (“*Bales*”).

A. Claims 1-8, 10-17, 19-21, and 33-39 are allowable because *Bales* fails to teach a method for supporting communications comprising “tunneling the message in the audio communication link to the remote device.”

This rejection relies heavily on inherency, but fails to satisfy the strict legal requirements for an inherency-based rejection. For this reason alone, the rejection must fail. Consider Applicant’s independent Claim 1, which recites:

A method for supporting communications comprising:
establishing a packet-based audio communication link with a remote device;
informing a local computing device of the audio communication link;
receiving a message from the local computing device, the message requesting identification of enhanced media capabilities associated with the remote device;
tunneling the message in the audio communication link to the remote device;
receiving a tunneled response in the audio communication link from the remote device, the response identifying the enhanced media capabilities associated with the remote device; and
forwarding the response to the local computing device.

Among other aspects, *Bales* fails to disclose “tunneling the message in the audio communication link to the remote device,” as Claim 1 requires. As teaching the claimed “tunneling” aspects, the Examiner relies on inherency. *See, e.g., Office Action* at p. 3; *Advisory Action* at p. 2 (“the inherency of tunneling is proper and the rejection is proper as well”). However, the Examiner has not met the strict legal requirements for sustaining a rejection based on inherency.

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present Inherency, however, may not be established by

probabilities or possibilities.” M.P.E.P. § 2112; *see In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, not only has the Examiner failed to satisfy the requirements for establishing inherency, the Examiner’s arguments actually demonstrate that an inherency-based rejection cannot be supported. As noted above, for inherency, the missing material must necessarily flow from the teachings of the applied prior art. If there are alternatives, then there cannot be inherency. In the present case, the Examiner himself states that there are alternatives. The Examiner states: “there are different ways to achieve successful signaling between devices.” *Advisory Action* at p. 2. The Examiner then describes, without reference to any supporting materials, that “tunneling” is one of these techniques. *Id.* The Examiner himself thus contends that there are alternatives and that tunneling is not necessary. Therefore, even if the Examiner’s conclusory statements are accepted as correct, the inherency-based rejection must fail.

Given the clear legal deficiencies, Applicant respectfully requests withdrawal of the rejection of Claims 1, 10, 19, 33, 35, and 39 and their respective dependent claims.

B. Claims 22-26 are allowable.

The *Office Action* fails to address the elements of independent Claim 22. Therefore, the *Office Action* fails to make a prima facie case for any rejection of Claim 22. Claim 22 and its dependent claims are allowable over the cited references.

- C. Claims 27-32 are allowable because *Bales* fails to teach a method for supporting communications comprising “aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device.”**

Consider Applicant’s independent Claim 27, which recites:

A method for supporting communications comprising:
associating a packet-based telephony device with a computing device;
determining media capabilities associated with the packet-based telephony device;
determining enhanced media capabilities associated with the computing device;
aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device; and
registering the aggregated media capabilities with a call manager, the call manager operable to associate the aggregated media capabilities with the packet-based telephony device.

Among other aspects, *Bales* fails to disclose “aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device,” as Claim 27 requires.

Claim 27 requires a method for supporting communications comprising “aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device.” As teaching these aspects, the *Office Action* points to *Bales*, figure 2 and 202. *Office Action*, p. 6-7. In describing element 202 of figure 2, *Bales* states, “switch node 102 transmits TRANS 202 message of FIG. 2 to switch node 103. This message also requests that a video capability be set up between switch node 102 and switch node 103.” Col. 3, lines 44-47. However, nothing in this cited portion or anywhere else in *Bales* describes, expressly or inherently, “aggregating the media capabilities associated with the packet-based telephony device and the enhanced media capabilities associated with the computing device,” as Claim 27 requires.

For at least these reasons, Claim 27 is allowable. Independent Claim 29 includes limitations that, for substantially similar reasons, are not taught by *Bales*. Because *Bales* does not describe every element of independent Claims 27 and 29, Applicant respectfully submits that the rejection of Claims 27 and 29 and their respective dependent claims contains clear factual and legal deficiencies.

CONCLUSION

As the rejections of the claims contain clear factual and legal deficiencies, Applicant respectfully requests withdrawal of all outstanding rejections and a finding of allowance all claims. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a stylized flourish at the end.

Kurt M. Pankratz

Reg. No. 46,977

Date: May 12, 2008

Customer No. **05073**